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09/681,154

01/31/2001

Robert M. Fries

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06/07/2005

WORKMAN NYDEGGER/MICROSOFT
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER

USTARIS, JOSEPH G

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,154

Applicant(s)

FRIES, ROBERT M.

Examiner

Joseph G. Ustaris

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,5-8,11-15,17-19 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,5-8,11-13,15,23 and 24 is/are rejected.
- 7) ☒ Claim(s) 14,17-19 and 25-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 05 January 2005 in application 09/681,154.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5-8, 11-13, 15, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US006557756B1) in view of Knowlton et al. (US006141006A).

Regarding claim 23, Smith discloses a communications module or "television tuning device" that is "able to at least translate an incoming signal into a picture on a display" (See Fig. 6, 8B, and 9; column 10 lines 38-49 and column 13 line 63 – column 14 line 2). Furthermore, the communications module is "also connected to the Internet" (See Fig. 12). The communications module is able to "display information comprising at least one of television programming and Internet content" (See Figs. 10a and 10b). The communications module has a power management scheme that utilizes a screensaver in standby mode. The communications module performs the method of "entering a screen saver mode upon detecting a first predetermined condition comprising user

inactivity" with the touch screen or "one input device operatively coupled to the television tuning device" (See column 17 lines 48-53). The communications module "replaces the displayed information with advertising information" (See column 18 lines 20-30). However, Smith does not disclose that "the advertising information is displayed with an exit segment that can be selected to exit the screen saver mode, wherein the television tuning device exits the screen saver mode in response to the exit segment being selected rather than exiting the screen saver mode in response to other user activity detected at the one input device".

Knowlton et al. (Knowlton) discloses a screen saver that displays advertisements to the users. The advertisements are displayed within a screen saver area, where the user can interact with the advertisements by clicking within the screen saver area, where the interaction will not exit the screen saver mode or "rather than exiting the screen saver mode in response to other user activity detected at the one input device". The user can exit the screen saver by clicking outside the screen saver display area or "the advertising information is displayed with an exit segment that can be selected to exit the screen saver mode" (See column 41 line 48 – column 42 line 41). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the screen saver and touch screen disclosed by Smith to display "the advertising information with an exit segment that can be selected to exit the screen saver mode, wherein the television tuning device exits the screen saver mode in response to the exit segment being selected rather than exiting the screen saver mode in response to other user activity detected at the one input device", as taught by

Knowlton, in order to increase the capabilities of the system thereby allowing the system to be more interactive with the user.

Claim 24 contains the limitations of claim 23 (where inherently the method is stored on "computer-readable medium" as "computer-executable instructions" in order for the communications module to successfully carry out its functions) and is analyzed as previously discussed with respect to those claims.

Regarding claim 3, the user clicking outside the screen saver display area is considered the "second predetermined condition comprising exiting of the screen saver mode", as discussed in claim 23, where inherently the screensaver displaying "advertising information" would be replaced with "the displayed information" on the display in "response to the second predetermined condition".

Regarding claim 5, "the advertising information comprises an offering for sale of at least one of a good and a service, such that the user is able to immediately purchase the at least one of the good and the service" (See Knowlton column 42 lines 20-41).

Regarding claim 6, the communications module periodically downloads the advertisements from the Internet and inherently "caches" the advertisements so when the communications module displays the advertisements it "retrieves the advertising information as previously cached" (See Smith column 18 lines 24-30).

Regarding claim 7, the communications module inherently "caches" the advertisements as they are downloaded as discussed in claim 6 above.

Regarding claim 8, the communications module is connected to the Internet (See Smith column 7 lines 12-17) and the advertisements are downloaded from the Internet

and inherently "cached" as discussed in claims 6 and 7 above (See Smith column 18 lines 20-36).

Regarding claim 11, inherently the system displays a "second advertising information on the display" when the user selects the advertisement or VLO that results in loading the corresponding network site (See Knowlton column 42 lines 27-36).

Regarding claim 12, the communications module uses an Internet Explorer browser to display a TV picture and advertisements (See Smith Fig. 10A and 10B). The advertisements are provided by an AD engine or "provided by an advertiser" (See Smith Fig. 13, AD engine and Retailer) where inherently the advertisements are written in "a predetermined markup language" in order to be displayed within the Internet Explorer browser (See Smith column 14 lines 49-55).

Regarding claim 13, "the predetermined markup language comprises HyperText Markup Language (HTML)" (See Smith column 14 lines 49-55).

Regarding claim 15, the advertisements are targeted advertisements based on household's demographic standings, recent buying patterns, or recent browsing patterns or "selecting the advertising information based on information particular to a user" (See Smith column 18 lines 24-30).

Allowable Subject Matter

3. Claims 14, 17-19, and 25-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 14, 17-19, and 25-28, the prior art of record fails to show or fairly suggest that entering the screen saver mode with advertising information comprises tuning to a different/particular television channel as recited in the claims.

Response to Arguments

4. Applicant's arguments with respect to claims 3, 5-8, 11-13, 15, 23 and 24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G. Ustaris whose telephone number is 571-272-7383. The examiner can normally be reached on M-F 7:30-5PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JGU
May 27, 2005



VIVEK SRIVASTAVA
PRIMARY EXAMINER